

Serial No. 09/769,938

Page 7

REMARKS

Claims 1-24 are pending in this application.

The Office Action maintains the rejection, under 35 U.S.C. § 103, claims 1-8 and 19-24 over DeLorme et al. (U.S. Patent No. 6,321,158) and claims 9-18 over Stilp et al. (U.S. Patent No. 6,159,465) and Wakabayashi et al. (U.S. Patent No. 5,794,222). These rejections are respectfully traversed.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the reference or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references, when combined, must teach or suggest all of the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure (MPEP 2142). The prior art must suggest the desirability of the claimed invention (MPEP 2143.01).

The Response to Arguments section alleges "Delorme states POI inputs are transferred and transform within the interform of a list of POIs found in proximity to a route previously computed, as revealed at 303 and detailed... in relation to Figs. 5, 6A & 6B (col. 44, lines 35-39)." The Response section further alleges, "An inputted POI is the user location." The Response section goes on to allege, "The found list POIs are the sorted record and the proximity is the zoned that found the list of POIs."

However, none of the above allegations satisfy sorting according to proximity of a related zone of data records in relation to a determined position of a user. In fact, none of the above allegations even hints at sorting anything in relation to a position of a user. The above allegations only allege an inputted POI is the user location. However, this is incorrect. In particular, a POI is a "point-of-interest" (col. 4, lines 32-31), not a user location.

Furthermore, the above noted sections do not even come close to disclosing sorting according to proximity of a related zone of data records in relation to a determined position of a user. In particular, even if any sorting were performed, all of the steps disclosed in the noted

Serial No. 09/769,938

Page 8

sections are performed at a home base desktop. Thus, the sorting cannot be performed in relation to a determined position of a user. More particularly, col. 44, lines 28-31 only disclose "the system also enables the generation and modification of lists of POI inputs by various methods for database searching and sorting well known in the art of computer programming." However, the system that performs database searching and sorting is only disclosed as located on a desktop computer, not on a device that can determine the position of a user within a zone. More particularly, searching and sorting is performed at a desktop computer prior to being loaded into a portable device (col. 6, lines 2-6, lines 50-53, lines 58-61, and col. 6, line 64 – col. 7, line 4). Additionally, col. 41, lines 52-60 expressly disclose the routing alleged by the Office Action is performed on a desktop, which would not bother determining the position of a user and sorting in relation to the position, because the position is always stationary. Thus, the above noted sections do not even come close to disclosing sorting according to proximity of a related zone of data records in relation to a position of a user.

Furthermore, the Office Action has not properly complied with MPEP §2144.03, as requested by Applicants in the previous Response. Accordingly, Applicants request withdrawal of the rejections as being improper.

The Response to Arguments section also disagrees with the lack of motivation to combine Stilp et al. with Wakabayashi et al. However, Applicants maintain there is no motivation to combine the references.

Initially, Applicants are confused by the Office Action's attempt to equate location records with physical mail. Applicants cannot ascertain how physical mail is equivalent to a database record and the Office Action has provided absolutely no evidence to support this allegation. Furthermore, such an allegation was not present in the previous Office Action. Thus, this allegation is a new grounds of rejection, as it is not present in any of the cited references. Furthermore, if the Office Action is alleging such is well known, and Applicants request evidence to support this allegation in accordance with MPEP §2144.03.

Also, the Office Action alleges "Stilp suggests creating a trigger wherein the trigger is sorting data system based on a location." Applicants disagree. Stilp only discloses triggering the

Serial No. 09/769,938

Page 9

Wireless Location System to begin processing (col. 6, lines 59-61). Stilp does not disclose using a trigger to sort data based on a location.

Additionally, the Office Action goes on to allege, "for example, the Wakabayashi is the mail sorting system based on the detecting of postal zone numbers." Yet, this does not amount to motivation to combine the references. In particular, Stilp et al. has no disclosure of postal zone numbers. Stilp et al. also has no disclosure of a mail sorting system. Thus, the Office Action still has not provided proper motivation to combine the references.

The original response follows below for the Examiner's convenience:

Applicant asserts there is absolutely no disclosure in DeLorme of sorting according to proximity of a related zone of data records in relation to a position of a user, as recited in independent claims 1 and 23. In fact, the Office Action admits DeLorme does not explicitly teach sorting according to proximity of a related zone of data records in relation to the position of a user. Furthermore, no reference is supplied that teaches this missing limitation.

There is absolutely no disclosure in DeLorme of sorting according to proximity of a related zone of data records in relation to the position of a user. As required by MPEP 2142, the prior art references, when combined, must teach or suggest all of the claim limitations. DeLorme does not teach or suggest the claimed feature of sorting according to proximity of a related zone of data records in relation to the position of a user. In fact, the Office Action admits this feature is not taught. Furthermore, the Office Action fails to provide a reference that teaches this feature. Thus, the prior art references fail to teach or suggest all of the claim features.

Additionally, DeLorme teaches away from sorting according to proximity of a related zone of data records in relation to the position of a user. In particular, as admitted by the Office Action, the user must return to the IRMIS system to modify the route or travel plan output. Accordingly, the user must leave a "zone" to sort the route or travel plan. Thus, records are not sorted according to a relation to a position of a user because the user must leave a zone to sort the records.

Furthermore, the Office Action alleges various methods for database searching and sorting are well known in the art of computer programming. However, Applicants have found no teaching of such a statement in DeLorme. Furthermore, the Office Action does not specify

Serial No. 09/769,938

Page 10

how such methods amount to sorting according to proximity of a related zone of data records in relation to the position of a user. If the Office Action is implying such is well known, Applicants traverse this assertion and request documentary evidence to support such an assertion in accordance with MPEP 2144.03. In particular, there is no basis for the allegation that sorting according to proximity of a related zone of data records in relation to the position of a user is well known.

Also, there is absolutely no motivation to perform sorting according to proximity of a related zone of data records in relation to a position of a user. Such motivation is not present in the cited reference and such is not well known. If the Office Action is alleging that such is well known, Applicants traverse this assertion and request documentary evidence to support such an assertion in accordance with MPEP 2144.03.

The Office Action also rejects, under 35 U.S.C. § 103, claims 9-18 over Stilp et al. (U.S. Patent No. 6,159,465) and Wakabayashi et al. (U.S. Patent No. 5,794,222). These rejections are respectfully traversed.

Applicants assert there is no motivation to combine Stilp et al. with Wakabayashi et al. The Office Action alleges such motivation is based on col. 2, lines 18-22. However, these statements only amount to the detection of fraud in a mail processing system. This does not amount to motivation to combine the teachings of Wakabayashi et al. with Stilp et al. In particular, Stilp et al. is directed to a wireless location system such as one used for E-911 calls (col. 1, lines 15-23, col. 4, lines 26-37). There is absolutely no disclosure of a mail processing system in Stilp et al. Thus, the disclosure of detecting fraud in a mail processing system in Wakabayashi et al. does not amount to motivation to combine teachings with a wireless location system in Stilp et al. Therefore, there is no motivation to combine the teachings of Wakabayashi et al. with Stilp et al.

Thus, Applicants respectfully submit that independent claims 1, 9, and 23 define patentable subject matter. The remaining claims depend from the independent claims and therefore also define patentable subject matter. Accordingly, Applicants respectfully request the withdrawal of the rejections under 35 U.S.C. § 103.

Serial No. 09/769,938

Page 11


CONCLUSION

Based on the foregoing amendments and remarks, Applicants respectfully submit this application is in condition for allowance. Favorable consideration and prompt allowance of claims 1-24 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the telephone number listed below.

The Commissioner is hereby authorized to deduct any fees arising as a result of this Amendment or any other communication from or to credit any overpayments to Deposit Account No. 50-2117.

Respectfully submitted,



Matthew C. Loppnow
Attorney for Applicant
Registration No. 45,314

Dated: June 25, 2004

Phone No. (847) 523-2585
Fax No. (847) 523-2350

Please send correspondence to:
Motorola, Inc.
Intellectual Property
600 North U.S. Highway 45
Libertyville, IL 60048